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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,978	02/08/2002	Vincent J. Gatto	EP-7532	3784

7590 10/22/2003

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EXAMINER

HOWARD, JACQUELINE V

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,978

Applicant(s)

GATTO, VINCENT J.

Examiner

Jacqueline V. Howard

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 29 to 37, 41 and 43 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Luciani et al (5,698,498).

Note Col 6 lines 35 to 58 for teaching which clearly anticipates the above claims,

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 to 28, 38-40, 42 and 44 to 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luciani et al (5,698,498) combined with Ward, Jr. (4,846,983) or Becker (3,578,690) or Gatto et al (6,174,842)

Luciani et al teach lubricating oil compositions, functional Fluids, greases and aqueous compositions comprising at least are hydroxyalkyl dithiocarbamate. The lubricants, greases and fluids are said to have improved anti-wear and extreme pressure properties. The hydroxyalkyldithiocarbamate is prepared by reacting an amine, carbon disulfide and an epoxide (note Col 2 lines 39-53). Patentee teaches the use of other additives together with the hydroxyalkyl dithiocarbamate including other extreme pressure and anti-wear agents. Metal thiocarbamates are specifically taught. (Col 25 lines 35-40 and Col 26 line 46.) The additives may also include solid lubricants such as molybdenum disulfide. (Col 30 lines 51-52)

The secondary references teach various molybdenum compounds which are known in the lubricant field as being conventional extreme pressure / anti-wear additives.


It is the examiner's position that the claimed invention would be obvious to one of ordinary skill in the art because combining two or more materials disclosed by the prior art for the same purpose to form a third material that is to be used for the same purpose has been held to be a prima facie case of obviousness.

With regards the claims to specific hydroxyalkyl compounds, it is the examiner's position that they would be obvious in view of Luciani since they are the reaction product of an epoxide, amine and carbon disulfide and the specific reactions used are encompassed by the broad teachings of the reference. No critically has been shown to exist in the selection of the specific reactants. It is not unobvious to follow the teachings of the prior art.

Any inquiry concerning this communication should be directed to J. V. Howard at telephone number (703) 308-2514.

J.V. Howard/lap

October 10, 2003


JACQUELINE V. HOWARD
PRIMARY EXAMINER
GROUP 1700